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In re Application of :
SIA, Charles D. Y. *et al* :
U.S. Application No.: 09/914,205 :
PCT No.: PCT/CA00/00190 :
Int. Filing Date: 24 February 2000 :
Priority Date: 24 February 1999 :
Attorney Docket No.: 1038-1176 MIS :
For: EXPRESSING GP140 FRAGMENT OF :
PRIMARY HIV-1 ISOLATE :

**DECISION ON
RENEWED PETITION
UNDER 37 CFR 1.47(a)**

This is a decision on applicants' "Renewed Petition under 37 C.F.R. 1.47(a)" filed on 30 January 2003.

BACKGROUND

On 26 September 2002, a decision dismissing applicants' petition under 37 CFR 1.47(a) was mailed for failing to meet all of the requirements.

On 30 January 2003, applicants filed the instant renewed petition which was accompanied by, *inter alia*, a three-month extension request and extension fee; a second declaration of Reza Yacoob ("2d.Decl."); a copy of the documents purportedly submitted to Mr. Sia ; a copy of FedEx Shipment Tracking Information; and a copy of an unsigned declaration.

DISCUSSION

As previously indicated, a petition under 37 CFR 1.47(a) requires: (1) the petition fee; (2) factual proof that the nonsigning inventor refuses to execute the application; (3) a statement of the last known address of the nonsigning inventor; (4) and an oath or declaration executed by the signing joint inventor on his behalf and on behalf of the non-signing joint inventor. Items (1) and (3) have been completed.

Concerning item (2), the 37 CFR 1.47(a) failed to satisfy this requirement with the original petition because it was unclear whether the declaration was received from the nonsigning inventor. Moreover, applicants were required to provide documentary evidence that Mr. Sia received a complete copy of the application and also attempt to contact the nonsigning inventor to verify his refusal to cooperate.

In this renewed petition, applicants have submitted another declaration by Reza Yacoob who states that there was a clerical error in the prior declaration and that the signed declaration has not been received from Mr. Sia. 2d.Decl. at ¶ 3. Ms. Yacoob also declares that she attempted to contact Mr. Sia via telephone on 18 November 2002 and left a message, but that he has not called back. Id. at ¶ 5.

The 37 CFR 1.47(a) applicant also provided copies of the documents submitted to the nonsigning inventor on 02 January 2002 along with a copy of the FedEx Shipment Tracking Information for reference number 215358 showing that this package was delivered on 10 January 2002. The statements of Ms. Yacoob and the documentary evidence provided are sufficient to meet the requirements of item (2).

However, the 37 CFR 1.47(a) applicant has still not met the requirement of item (4) which requires a signed oath or declaration by the signing joint inventor on his behalf and on behalf of the non-signing joint inventor.

Previously, the 37 CFR 1.47(a) applicant included a declaration signed by four of the five co-inventors listed on the international publication. But the 37 CFR 1.47(a) applicant provided one complete declaration and one partial declaration consisting of only one page. The prior decision dated 26 September 2002 explained that "[w]hile each inventor need not execute the same oath or declaration, each oath or declaration executed by an inventor must contain a complete listing of all inventors so as to clearly indicate what each inventor believes to be the appropriate inventive entity."

In the renewed petition, Ms. Yacoob explains that "a complete Declaration and Power of Attorney document . . . was forwarded to Mr. Rovinski for his signature on behalf of the non-signing inventor, Charles D.Y. Sia, and he returned just the page bearing his signature." Id. at ¶ 7. This explanation is insufficient.

The 37 CFR 1.47(a) must submit a copy of the complete declaration signed by each co-inventor. If the 37 CFR 1.47(a) applicant is unable to obtain a complete declaration signed by Mr. Rovinski, then he should be treated as an uncooperative inventor. This requirement will not be waived.

Therefore, all of the requirements of 37 CFR 1.47(a) are not yet complete.

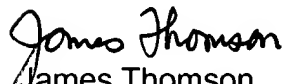
CONCLUSION

For the reasons discussed above, applicants' renewed petition under 37 CFR 1.47(a) is **DISMISSED** without prejudice.

If reconsideration on the merits of this petition is desired, a proper response must be filed within **TWO (2) MONTHS** from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under

37 CFR 1.47(a)." Extensions of time may be obtained under 37 CFR 1.136(a).

Applicants are advised that, effective May 1, 2003, the Office changed its correspondence address. Any further correspondence with respect to this matter deposited with the United States Postal Service should be addressed to the Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.


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